

Application No. 09/648,102  
Attorney Docket No. JDC-001-US  
Resp To September 16, 2004 Office Action

## **REMARKS**

### ***PRIOR ART REJECTIONS***

Claims 1-27, 36-45, 47, 48 and 50-58 are currently pending. All of the pending claims are rejected under 35 U.S.C. §103 as being unpatentable over Downing et al. (U.S. Pat. No. 5,963,647) in view of various prior art references.

Claims 1, 9, 15, 20, 21, 38, 39, 44, 47, 50, 51, and 54 have been amended to return the claims to the status as of the time of the May 19, 2004 office action, except for the amendments to claims 15, 20 and 21 to correct antecedent basis errors and remove redundant language, in which claims 1-27, 36-45, 47-48 and 54-58 were rejected under 35 U.S.C. §103 as being unpatentable over Downing et al. (U.S. Pat. No. 5,963,647) in view of Picciallo (U.S. Pat. No. 6,044,360) and claims 50-53 were rejected under 35 U.S.C. §103 as being unpatentable over Downing and Picciallo in view of Gorder et al. (U.S. Pat. No. 5,936,221). Claim 37 has been amended to correct an inadvertent typographical error. Thus, the new grounds for rejection are moot, but the claims remain rejected under the previously stated grounds.

Regardless of the reasoning, whether as applied by the Examiner in the May 19, 2004 office action or the September 16, 2004 office action, the claims have been rejected under 35 U.S.C. §103. While the applicant disagrees, as stated in the applicant's prior amendments, with the reasoning applied by the Examiner and reserves the right to raise those arguments on appeal, applicant submits that the claims are non-obvious in light of secondary considerations. See, *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). As set forth in great detail in the declaration of the inventor, Jonathan Cooper, pursuant to 37 C.F.R. §1.132, the objective evidence of non-obviousness includes a long felt but unsolved need for a solution to the problems of conventional wire transfer services, failed attempts by others to solve the problems, and commercial success of the present invention. The objective evidence overwhelmingly counters the hindsight applied by the Examiner in rejecting the present claims.

After failed attempts by Western Union, Citibank and others to solve the long-felt problems associated with conventional wire transfer services, the present invention provided a commercially successful alternative. The commercial success is demonstrated by the SafeSend product offered by Bank of America, which owes its success as explained in the Cooper declaration as being due to technical advantages provided by the present invention. Further, the SafeSend product is commensurate with the scope of the claims as the petition to make special,

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which was granted in connection with the present application, was precipitated by the launch of the SafeSend product. The applicant is entitled to rely on the commercial success of third parties. See e.g., *American Standard, Inc. v. Pfizer Inc.*, 828 F.2d 734, 742-43 (Fed. Cir. 1987); *Truswal Sys. Corp. v. Hydro-Air Eng'g, Inc.*, 813 F.2d 1207, 1212 (Fed.Cir.1987).

### CONCLUSION

Applicant respectfully submits that the claims are allowable over the prior art and requests the timely issuance of a notice of allowance.

Respectfully submitted,



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